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10/651,687	08/29/2003	Randolph S. Kohlman	2127B	9217

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EXAMINER

SALVATORE, LYNDIA

ART UNIT PAPER NUMBER

1771

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/651,687
Filing Date: August 29, 2003
Appellant(s): KOHLMAN ET AL.

George M Fisher
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/13/06 appealing from the Office action mailed 8/15/05.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,809,573	Feitlowitz	5-1974
5,534,298	Cross et al	7-1996
6,159,877	Scholz et al	12-2000
3,889,024	Drelich et al	6-1975

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102/103

- a) Claims 73-80 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Feitlowitz (U.S. Patent No. 3,809,573).

Feitlowitz discloses a method for imparting increased stiffness to woven and non-woven fabrics (column 1, lines 15-27). Feitlowitz teaches thoroughly impregnating the fabric with a polymeric composition (column 2, lines 42-49).

Although Feitlowitz does not explicitly teach the limitations of Kawabata stiffness values or Kawabata surface friction values, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. textile composition) and in the similar production steps (i.e. impregnating with a stiffening polymer) used to produce the fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594.

In the alternative, the claimed stiffness values would obviously have been present since the Feitlowitz process teaches adjusting the stiffness level (column 2, lines 50-69). Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

With regard to claim 79, the textile substrate is polyester (column 2, line 72). With regard to claim 80, Feitlowitz teaches the polymer thoroughly impregnates the fabric (column 2, lines 45-46), so the polymer would form anchoring structures.

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b) Claims 73-79 and 81 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cross et al. (U.S. Patent No. 5,534,298).

Cross et al., disclose a stiff woven fabric with a polymeric coating (Abstract).

Although Cross et al., do not explicitly teach the limitations of Kawabata stiffness values or Kawabata surface friction values, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. textile composition) and in the similar production steps (i.e. coating with a stiffening polymer) used to produce the fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594.

In the alternative, the claimed stiffness values would obviously have been present since the Cross et al., process teaches varying the levels of stiffness (column 5, lines 27-39). Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

With regard to claims 79 and 81, the woven textile substrate may be 150 denier polyester (column 5, lines 7-26) and the coating is pressed into the fabric interstices (column 6, lines 4-6).

Claim Rejections - 35 USC § 103

c) Claims 81 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feitlowitz in view of Scholz et al. (U.S. Patent No. 6,159,877).

Feitlowitz does not disclose the denier size of the yarn or a warp knitted fabric. Scholz et al., teach a fabric with a controlled stiffness useful as an orthopedic support material (column 2, lines 45-60). Scholz et al. disclose manufacturing a woven or warp knitted fabric (column 7, line 57 –column 8, line 21) with a yarn denier of less than 500 (column 8, lines 35-36).

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It would have been obvious to a person having ordinary skill in the art at the time of the invention to use the fabric disclosed by Scholz et al., in the invention of Feitlowitz in order to provide a fabric material that is useful as an orthopedic support, as taught by Scholz et al.

d) Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feitlowitz in view of Drelich et al. (U.S. Patent No. 3,889,024).

Feitlowitz discloses making a non-woven fabric (column 1, line 45). However, Feitlowitz does not teach the length of the fibers. Drelich et al., however, teach that non-woven fabrics are conventionally made from fibers having a length between 0.5 and 2.5 inches (column 2, lines 36-40). Absent any specific teaching by Feitlowitz as to the length of the fibers, it would have been necessary to look to the prior art to identify suitable fiber lengths which can be used to produce non-woven fabrics. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use fibers with a length that is conventional in the art of non-woven fabrics. Applicant's claimed fiber length range falls within what is conventional in the art for non-woven fabrics.

(10) Response to Argument

Claim Rejections - 35 USC § 102/103

a) Claims 73-80 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Feitlowitz (U.S. Patent No. 3,809,573).

Applicant argues that the burden of proof has not shifted to the Applicant with regards to the Examiner's assertion that the textile composition of Feitlowitz inherently possesses the claimed Kawabata stiffness values and surface friction values. Applicant argues that Feitlowitz uses generally dissimilar materials and clearly dissimilar processes than Applicant in the creation

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of the textile composition. To support this argument, Applicant points out that Feitlowitz uses 100% polyester fabrics and that the resulting fabric in Feitlowitz is “very stiff.” However, it must be pointed out that Applicant claims a polyester textile substrate (claim 79). This is clearly a similar material. Also, Feitlowitz impregnates the fabrics with a stiffening polymer (column 1, lines 58-67). This is similar to Applicant’s claim of a textile substrate impregnated with a polymer facing to provide for a certain degree of stiffness (claim 73). In light of this, Applicant’s argument that the materials and process are dissimilar is unclear. The Examiner has found prior art that meets the claimed structural and material limitations. Since no other structural or chemical features are claimed which may distinguish the present invention from the Feitlowitz invention, the presently claimed Kawabata stiffness and surface friction values deemed to be inherent to the Feitlowitz invention.

Where the Examiner has reason to believe a property asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, (s)he possesses the authority to require Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon. *In re Swinehart*, 169 USPQ 226,229 Applicant should take this as the Office evocating its authority.

Currently, it would be necessary for the skilled artisan to perform an experiment with every known textile comprising a polymer face to determine infringement. The Office believes it is Applicant’s duty to provide claims that are sufficiently specific so a determination of infringement can be made without undue experimentation *Ex parte Slob*, 157 USPQ 172

Additionally, while the Office recognizes a material of unknown structure can be claimed by a combination of physical and chemical characteristics *Ex parte Brian et al.*, 118 USPQ 242,

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a sufficient number of characteristics must be set forth so as to identify what was invented *Ex parte Siddiqui*, 156 USPQ 426; *Ex parte Davission*, 133 USPQ 400; *Ex parte Fox*, 128 USPQ 157. In the instant case, Applicant's sparse of number of characteristics fails to identify anything to workers in the art. The rejected claims merely represent a desired outcome rather than the setting forth the limitations or characteristics to achieve the inventive entity.

b) Claims 73-79 and 81 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cross et al. (U.S. Patent No. 5,534,298).

With regard to Applicant's lack of inherency arguments, the arguments made above in the Feitlowitz rejection also apply to the Cross et al. reference.

Applicant argues that Cross et al., uses a process that does not result in the penetration of the compound to the opposite side of the fabric. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., penetration of the compound to the other side of the) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that they are concerned with the smoothness of the composite surface, a consideration that appears to be of little or no importance to Cross et al. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., smoothness of the composite surface) are not recited in the rejected claim(s). Although the claims are interpreted in light of the

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specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

c) Claims 81 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feitlowitz in view of Scholz et al. (U.S. Patent No. 6,159,877).

In response to applicant's argument that there is no suggestion to combine the Scholz et al., and Feitlowitz references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant case, one of ordinary skill in the art would use the fabric type and denier size disclosed by Scholz et al. in order to provide a fabric that is suitable as an orthopedic support.

d) Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feitlowitz in view of Drelich et al. (U.S. Patent No. 3,889,024).

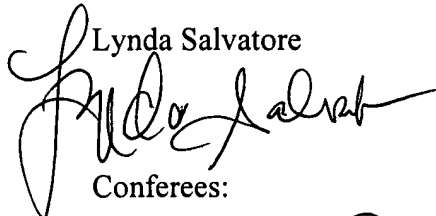
In response to applicant's argument that there is no suggestion to combine the Drelich et al., and Feitlowitz references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21


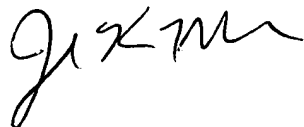
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USPQ2d 1941 (Fed. Cir. 1992). In the instant case, one of ordinary skill in the art would look to the prior art to identify suitable lengths of fibers which can be used to produce non-woven fabrics.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Lynda Salvatore

Conferees:

Terrel Morris - 
Jennifer Kolb-Michener 


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